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## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/524,590

Filing Date: March 14, 2000

Appellant(s): KRAUSE, PHILIP R

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Philip, Krause  
For Appellant

## EXAMINER'S ANSWER

This is in response to the appeal brief filed on May 03, 2005.

### (1) Real Party in Interest

The appellant's statement of the real party in interest contained in the brief is correct.

**(2) Related Appeals and Interferences**

The appellant's statement of the related appeals and interferences contained in the brief is correct.

**(3) Status of Claims**

The appellants' statement of the status of the claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues contained in the brief is correct.

**(7) Grouping of Claims**

The appellant's statement of the grouping of the claims in the brief is correct.

**(8) ClaimsAppealed**

The copy of the appealed claims contained in the appendix pages 43-48 is correct.

**(9) Prior Art of Record**

Sotomayor, U.S. Patent Number 5,708,825, issued on January 13, 1998, and filed on May 26, 1995 (hereinafter Sotomayor).

Meske, Jr. et al., U.S. Patent Number 5,530,852, issued on June 25, 1996, and filed on December 20, 1994 (hereinafter Meske).

Boguraev, U.S. Patent Number 6,212,494 B1, issued on April 3, 2001, and filed on July 20, 1998 (hereinafter Boguraev).

**(10) New Prior Art**

No new prior art has been applied in this examiner's answer.

**(11) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims 36-69:

Claims 36-41 and 43-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sotomayor, Patent No. 5,708,825 and further in view of Meske, Jr. et al. (Meske), Patent No. 5,530,852.

As to claims 36, 68 and 69, Sotomayor discloses a method for using a computer system, in response to a reader's request for display of electronic text, to automatically identify and provide additional reading material related to concepts referred to within said electronic text comprising, in sequence, the steps of:

- a) accessing, using the reader's computer, electronic text requested for display by the reader, said electronic text containing at least one text section (col. 5, line 53 – col. 7, line 10: a viewer viewing documents uses a web browser to access the documents that a database provider may make available on the network, each document might have plurality of pages, and each page contains a portion of a source document);
- c) automatically searching an index, wherein
  - i) said index contains a plurality of terms by which it may be searched (col. 3, line 41 – col. 4, line 8, col. 6, lines 31-48, col. 8, lines 44-60, and col. 35, lines 48-57: summary pages can be created which contain a table of

contents, a concept index, a phrase index, abstract index (key topic index), and viewers can view the summary pages, and the viewers also can search for text strings a in a conventional text-viewing program);

ii) substantially all terms in said index are associated with at least one pointer to a text section (col. 3, line 41 – col. 4, line 8, col. 6, lines 31-48, and col. 8, lines 44-62 and Abstract: any key index above would include hyperlinks to destination anchors where those key topics appear in the presentation pages generated from source document); and

iii) at least one term in said index is associated with a plurality of pointers, at least two of said plurality of pointers pointing to different text sections (col. 3, line 41 – col. 4, line 21, and col. 8, lines 44-62: key topic index is an index term for the key topic and an associated source anchor or combination anchor that are hyperlinked to occurrences of that key topic in the source document or their derivative document);

Sotomayor provides viewer with an indexed and/or hyperlinked view of a document wherein a view can view and search for text strings having important key topics marked and indexed (col. 35, lines 48-57). However, Sotomayor does not explicitly disclose b) using said at least one text section to automatically formulate, on the reader's computer, a search request related to a concept referred to in said at least one text section; d) responsive to step (c), automatically identifying additional reading material related to said concept; and e) automatically displaying on said reader's

computer display, an indicator of said additional reading material together with at least one link to a source of said additional reading material, side-by-side with a portion of the electronic text referred to in step (a). Meske Jr. discloses a method for retrieving information by displaying to a user a display generated from a first markup language containing a list of profiles and at least one corresponding topic for each of the list of profiles and allowed user to enter search term, and the search is performed using the search term in a database which is organized by the list of the profiles and the at least one corresponding topic for each of the list of profiles (col. 2, line 56 – col. 3, line 8). Meske Jr. also discloses the search result may also create certain HTML files responsive to user search requests and additional HTML files created responsive thereto, wherein anchors are created in the various files in order to allow hypertext cross-referencing of the various related file and/or documents (col. 5, lines 58 – col. 7, line 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Meske Jr. and Sotomayor to include using said at least one text section to automatically formulate, on the reader's computer, a search request related to a concept referred to in said at least one text section; automatically identifying additional reading material related to said concept; and automatically displaying on said reader's computer display, an indicator of said additional reading material together with at least one link to a source of said additional reading material, side-by-side with a portion of the electronic text referred. Meske Jr. provides information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality

of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing.

As to claim 37, Sotomayor and Meske Jr. (Sotomayor-Meske) disclose wherein said additional reading material of step d is accessible over a network (Sotomayor, col. 5, line 53 – col. 6, line 17 and Meske Jr. discloses a method for retrieving information by displaying to a user a display generated from a first markup language containing a list of profiles and at least one corresponding topic for each of the list of profiles and allowed user to enter search term, and the search is performed using the search term in a database which is organized by the list of the profiles and the at least one corresponding topic for each of the list of profiles (col. 2, line 56 – col. 3, line 8). Meske Jr. also discloses the search result may also create certain HTML files responsive to user search requests and additional HTML files created responsive thereto, wherein anchors are created in the various files in order to allow hypertext cross-referencing of the various related file and/or documents (col. 5, lines 58 – col. 7, line 2)).

As to claim 38, Sotomayor-Meske disclose wherein said network is the internet (Sotomayor, col. 5, line 53 – col. 6, line 17).

As to claim 39, Sotomayor-Meske disclose wherein the method of formulating said search request comprises selecting certain words from said text section, wherein

said index includes words present in other text sections, and wherein said additional reading material contains all words in said search request (Meske, Figs. 8 and 9, col. 10, line 41 – col. 11, line 5: Meske Jr. provides information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing. Sotomayor and Meske Jr. are analogous art because they are from the same field of endeavor that is retrieving information from index files. The suggestion/motivation for doing so would have been to provide information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing. Therefore, it would have been obvious to combine Sotomayor and Meske Jr. to obtain the invention as specified in claim 36).

As to claim 40, Sotomayor-Meske disclose wherein the method of formulating said search request comprises analyzing said text section for the presence of combinations of certain words in a specific order and within a specified proximity of one another wherein said index includes words from other text sections, and wherein said additional reading material contains the same combinations of certain words in said

specific order and within said specified proximity of one another (Sotomayor, col. 4, lines 11-48; Meske, col. 5, line 58 – col. 6, line 14).

As to claim 41, Sotomayor-Meske disclose wherein the method of formulating said search request comprises analyzing said text section for patterns of word usage that are recognized by the computer system to relate to a concept (Sotomayor, col. 4, lines 10-21).

As to claim 43, Sotomayor-Meske disclose wherein the method of formulating said search request comprises analyzing said text section for citation of references, and wherein said additional reading material cites at least one source cited by said text section (Meske Jr. discloses a method for retrieving information by displaying to a user a display generated from a first markup language containing a list of profiles and at least one corresponding topic for each of the list of profiles and allowed user to enter search term (search an index in step c) (Fig. 10), and the search is performed using the search term in a database which is organized by the list of the profiles and the at least one corresponding topic for each of the list of profiles (col. 2, line 56 – col. 3, line 8). Meske Jr. also discloses the search result may also create certain HTML files responsive to user search requests (in response to step c above) and additional HTML files created responsive thereto, wherein anchors are created in the various files in order to allow hypertext cross-referencing of the various related file and/or documents (col. 5, lines 58 – col. 7, line 2, Fig. 9, 10, 11A-11C and 12A-12B). Sotomayor and Meske Jr. are

analogous art because they are from the same field of endeavor that is retrieving information from index files. The suggestion/motivation for doing so would have been to provide information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing. Therefore, it would have been obvious to combine Sotomayor and Meske Jr. to obtain the invention as specified in claim 36).

As to claim 44, Sotomayor-Meske disclose wherein the method of formulating said search request comprises analyzing said text section for embedded commands (Sotomayor, col. 6, lines 18-48).

As to claim 45, Sotomayor-Meske disclose wherein the method of formulating said search request comprises statistical analysis of word usage within said text section (Sotomayor, col. 15, lines 48 – 67).

As to claim 46, Sotomayor-Meske disclose wherein the method of formulating said search request comprises identifying an index entry referring to said text section (Sotomayor, col. 15, lines 48-67).

As to claim 47, Sotomayor-Meske disclose wherein said search request is contained in a list of potential search terms (Sotomayor, col. 15, lines 48-67).

As to claim 48, Sotomayor-Meske disclose wherein said search request comprises words within said text section of step (a) (Meske, Figs. 9 and 10, col. 10, line 41 – col. 11, line 5: Meske Jr. provides information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing).

As to claim 49, Sotomayor-Meske disclose wherein said search request comprises a plurality of words (Meske, Figs. 9 and 10, col. 10, line 41 – col. 11, line 5: Meske Jr. provides information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing).

As to claim 50, Sotomayor-Meske disclose wherein said search request comprises a synonym of at least one word in said text section (Sotomayor, col. 17, lines 5-18).

As to claim 51, Sotomayor-Meske disclose wherein said additional reading material is related to said section of text by discussion of identical concept (Sotomayor, col. 9, line 26 – col. 10, line 22).

As to claim 52, Sotomayor-Meske disclose wherein said additional reading material is related to said section of text by discussion of concepts that are related to one another (Sotomayor, col. 9, line 26 – col. 10, line 22).

As to claim 53, Sotomayor-Meske disclose wherein said concepts are considered related to one another when both are related to a third concept (Meske, Abstract: Meske Jr. provides information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing. Sotomayor and Meske Jr. are analogous art because they are from the same field of endeavor that is retrieving information from index files. The suggestion/motivation for doing so would have been to provide information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing. Therefore, it would

have been obvious to combine Sotomayor and Meske Jr. to obtain the invention as specified in claim 36.)

As to claim 54, Sotomayor-Meske disclose wherein said concepts are considered related to one another when one is included within the other (Sotomayor, col. 9, line 26 – col. 10, line 22).

As to claim 55, Sotomayor-Meske disclose wherein said index is an author's index to said requested text (Sotomayor, col. 17, line 50 – col. 18, line 36).

As to claim 56, Sotomayor-Meske disclose wherein said index is generated automatically by a computer system (Sotomayor, Abstract).

As to claim 57, Sotomayor-Meske disclose wherein said index is a search engine (Sotomayor, col. 35, lines 48-57).

As to claim 58, Sotomayor-Meske disclose wherein said index is accessed via a computer network (Sotomayor, col. 5, line 53 – col. 6, line 17).

As to claim 59, Sotomayor-Meske disclose wherein said display occurs in a browser window (Sotomayor, col. 5, line 53 – col. 6, line 17).

As to claim 60, Sotomayor-Meske disclose wherein said indicator of additional reading material is an excerpt of said additional reading material (Sotomayor, col. 9, line 26 – col. 10, line 22).

As to claim 61, Sotomayor-Meske disclose wherein the indicator of additional reading material is an index term (Sotomayor, col. 9, line 26 – col. 10, line 22).

As to claim 62, Sotomayor-Meske disclose wherein the computer system obtains input from the reader regarding the types of relationships between references to concepts to provide information about in step (d) (Sotomayor, col. 6, lines 18-48).

As to claim 63, Sotomayor-Meske disclose wherein the computer system obtains input from the reader regarding the strength of relationships between related concepts to provide information about (Sotomayor, col. 6, lines 18-48).

As to claim 64, Sotomayor-Meske disclose wherein said indicator of additional reading material is displayed on an outline of at least one text (Meske, Abstract and Figs. 9-11: Meske Jr. provides information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing).

As to claim 65, Sotomayor-Meske disclose wherein said index to be searched may be selected by the reader (Sotomayor, col. 35, lines 48-57).

As to claim 66, Sotomayor-Meske disclose wherein additional information resident on the reader's computer influences said search request (Meske, Abstract and Figs. 9-11: Meske Jr. provides information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing).

As to claim 67, Sotomayor-Meske disclose wherein said text requested by the reader is obtained via a computer network (Sotomayor, col. 5, line 53 – col. 6, line 17).

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sotomayor and Meske as applied to claims 36-41 and 43-69 above, and further in view of Buguraev, Patent No. 6,212,494.

As to claim 42, Sotomayor-Meske disclose the limitations as discussed above. However, Sotomayor-Meske do not explicitly disclose wherein the method of formulating said search request comprises analyzing the frequency with which at least

one word appears in said text section relative to other words. Buguraev discloses a method for creating a catalog comprising key terms, properties thereof, relations involving those key terms for a given topic comprises clustering key terms on the basis of proximity in terms of their relative position in the text (col. 4, line 60 – col. 5, line 48). Since Buguraev teaches a method for creating a glossary, index, help database or the like, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the index method of Buguraev into the search system of Sotomayor-Meske to include gathering key terms on the basis of proximity in terms of relative position in the text. By doing so, it would create an online help database useful in providing online assistance to users in performing a task.

**(12) Response to Argument**

The examiner summarizes the various points raised by the appellant and addresses replies individually.

As per appellants' arguments filed on May 03, 2005, the appellants argue in substance:

**1. General arguments common to all claims**

**1-a.** "The final rejection contains errors in reasoning, fails to properly apply the Graham (Graham v. John Deer Co.) factual inquiries, and does not establish a prima facie case of obviousness." (see page 8 of Brief)

**In reply** to argument in point **1-a**, Graham v. Deere is test for obviousness. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

**Determining the scope and contents of the prior art** (In considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826-27, 159 USPQ 342, 344 (CCPA 1968). See also *In re Shepard*, 319 F.2d 194, 197, 138 USPQ 148, 150 (CCPA 1963). In determining the content of the prior art, references must read for what they imply to one of ordinary skill in the art as well as for what they state expressly, also, scope and content art are determined at the time an invention was made).

**Ascertaining the differences between the prior art and the claims at issue** (identify what is claimed, identify what the reference disclose and determine what is missing from the reference).

In this case, Sotomayor discloses a method for using a computer system, in response to a reader's request for display of electronic text, to automatically identify and

provide additional reading material related to concepts referred to within said electronic text comprising, in sequence, the steps of:

- a) accessing, using the reader's computer, electronic text requested for display by the reader, said electronic text containing at least one text section (col. 5, line 53 – col. 7, line 10: a viewer viewing documents uses a web browser to access the documents that a database provider may make available on the network, each document might have plurality of pages, and each page contains a portion of a source document);
- c) automatically searching an index, wherein
  - i) said index contains a plurality of terms by which it may be searched (col. 3, line 41 – col. 4, line 8, col. 6, lines 31-48, col. 8, lines 44-60, and col. 35, lines 48-57: summary pages can be created which contain a table of contents, a concept index, a phrase index, abstract index (key topic index), and viewers can view the summary pages, and the viewers also can search for text strings a in a conventional text-viewing program);
  - ii) substantially all terms in said index are associated with at least one pointer to a text section (col. 3, line 41 – col. 4, line 8, col. 6, lines 31-48, and col. 8, lines 44-62 and Abstract: any key index above would include hyperlinks to destination anchors where those key topics appear in the presentation pages generated from source document); and
  - iii) at least one term in said index is associated with a plurality of pointers, at least two of said plurality of pointers pointing to different text sections

(col. 3, line 41 – col. 4, line 21, and col. 8, lines 44-62: key topic index is an index term for the key topic and an associated source anchor or combination anchor that are hyperlinked to occurrences of that key topic in the source document or their derivative document);

Sotomayor provides viewer with an indexed and/or hyperlinked view of a document wherein a view can view and search for text strings having important key topics marked and indexed (col. 35, lines 48-57). However, Sotomayor does not explicitly disclose b) using said at least one text section to automatically formulate, on the reader's computer, a search request related to a concept referred to in said at least one text section; d) responsive to step (c), automatically identifying additional reading material related to said concept; and e) automatically displaying on said reader's computer display, an indicator of said additional reading material together with at least one link to a source of said additional reading material, side-by-side with a portion of the electronic text referred to in step (a).

**Resolving the level of ordinary skill in the pertinent art.** Each art has its own level of ordinary skill. The "hypothetical person having ordinary skill in the art' to which the claimed subject matter pertains would, of necessity have the capability of understanding the scientific and engineering principles applicable to the pertinent art."

Ex parte Hiyamizu, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Inter. 1988).

**Considering objective evidence present in the application indicating obviousness or nonobviousness.**

In this case, Sotomayor provides viewer with an indexed and/or hyperlinked view of a document wherein a view can view and search for text strings having important key

topics marked and indexed (col. 35, lines 48-57). However, Sotomayor does not explicitly disclose b) using said at least one text section to automatically formulate, on the reader's computer, a search request related to a concept referred to in said at least one text section; d) responsive to step (c), automatically identifying additional reading material related to said concept; and e) automatically displaying on said reader's computer display, an indicator of said additional reading material together with at least one link to a source of said additional reading material, side-by-side with a portion of the electronic text referred to in step (a). Meske Jr. discloses a method for retrieving information by displaying to a user a display generated from a first markup language containing a list of profiles and at least one corresponding topic for each of the list of profiles and allowed user to enter search term (search an index in step c) (Fig. 10), and the search is performed using the search term in a database which is organized by the list of the profiles and the at least one corresponding topic for each of the list of profiles (col. 2, line 56 – col. 3, line 8). Meske Jr. also discloses the search result may also create certain HTML files responsive to user search requests (in response to step c above) and additional HTML files created responsive thereto, wherein anchors are created in the various files in order to allow hypertext cross-referencing of the various related file and/or documents (col. 5, lines 58 – col. 7, line 2, Fig. 9, 10, 11A-11C and 12A-12B).

Sotomayor and Meske Jr. are analogous art because they are from the same field of endeavor, that is retrieving information from index files.

The suggestion/motivation for doing so would have been to provide information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing.

Therefore, it would have been obvious to combine Sotomayor and Meske Jr. to obtain the invention as specified in claim 36.

**1-b.** Specific limitations in independent claims 36, 68, and 69 are not described in the prior art relied on in the rejection. (Please see response to argument in point 1-a above)

**1-c.** The references, taken as a whole, do not suggest the subject matter of claims 36, 68 and 69.

In reply to argument 1-c that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Please see the rejection and response to argument 1-a above.

**1-d.** Features disclosed in one reference may not properly be combined with feature disclosed in another reference to arrive at claims 36, 68, or 69.

I. No motivation to combine Sotomayor with Meske is described in the references or in the knowledge generally available to one of ordinary skill in the art.

In reply to argument I, Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Sotomayor and Meske Jr. are analogous art because they are from the same field of endeavor, that is retrieving information from index files. The suggestion/motivation for doing so would have been to provide information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing. Therefore, it would have

been obvious to combine Sotomayor and Meske Jr. to obtain the invention as specified in claim 36.

II. Sotomayor and Meske are individually complete.

In reply to argument II, Sotomayor discloses creating summary pages by automatically identifying key topics, concepts, and phrases in the documents and indexing them so users can retrieve and search the index (Abstract, col. 4, lines 10-48 and col. 35, lines 48-57). Meske disclose a searchable index web site that users can search and retrieve information from an index database (Abstract and Figs. 9-10, 11A-11C and 12A-12B). Therefore, Sotomayor and Meske Jr. are analogous art because they are from the same field of endeavor that is retrieving information from index files.

III. Sotomayor teaches away from the present invention and from combination with Meske.

In reply to argument III, the appellant's argument that "Sotomayor teaches away from the present invention and from combination with Meske", the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary references; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416F.2d 738, 1385 USPQ 545 (CCPA 1969). In this case, However, Sotomayor does not explicitly disclose b) using said at least one text section to automatically formulate, on the reader's computer, a search request related to a concept referred to in said at least one text section; d) responsive to step (c), automatically identifying additional reading material related to said concept; and e) automatically displaying on said reader's computer display, an indicator of said additional reading material together with at least one link to a source of said additional reading material, side-by-side with a portion of the electronic text referred to in step (a). Meske Jr. discloses a method for retrieving information by displaying to a user a display generated from a first markup language containing a list of profiles and at least one corresponding topic for each of the list of profiles and allowed user to enter search term (search an index in step c) (Fig. 10), and the search is performed using the search term in a database which is organized by the list of the profiles and the at lest one corresponding topic for each of the list of profiles (col. 2, line 56 – col. 3, line 8). Meske Jr. also discloses the search result may also create certain HTML files responsive to user search requests (in response to step c above) and additional HTML files created responsive thereto,

wherein anchors are created in the various files in order to allow hypertext cross-referencing of the various related file and/or documents (col. 5, lines 58 – col. 7, line 2, Fig. 9, 10, 11A-11C and 12A-12B). Sotomayor and Meske Jr. are analogous art because they are from the same field of endeavor, that is retrieving information from index files. The suggestion/motivation for doing so would have been to provide information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing. Therefore, it would have been obvious to combine Sotomayor and Meske Jr. to obtain the invention as specified in claim 36.

**2. Specific limitations in the dependent claims are not described in the prior art relied on in the rejection, and appropriate motivation for combination of references to arrive at dependent claims is not provided.**

a. Claim 39, Sotomayor-Meske disclose wherein the method of formulating said search request comprises selecting certain words from said text section, wherein said index includes words present in other text sections, and wherein said additional reading material contains all words in said search request (Meske, Figs. 8 and 9, col. 10, line 41 – col. 11, line 5: Meske Jr. provides information retrieval, which includes the receipt of a

plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing. Sotomayor and Meske Jr. are analogous art because they are from the same field of endeavor, that is retrieving information from index files. The suggestion/motivation for doing so would have been to provide information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing. Therefore, it would have been obvious to combine Sotomayor and Meske Jr. to obtain the invention as specified in claim 36).

b. Claims 41, 44, 45, 46, 47 and 50, since Examiner's cited the first reference which is Sotomayor for rejecting claims 41, 44, 45, 46, 47 and 50, therefore, there is no need to provide motivation.

c. Claim 43, Sotomayor-Meske disclose wherein the method of formulating said search request comprises analyzing said text section for citation of references, and wherein said additional reading material cites at least one source cited by said text section (Meske Jr. discloses a method for retrieving information by displaying to a user a display generated from a first markup language containing a list of profiles and at least

one corresponding topic for each of the list of profiles and allowed user to enter search term (search an index in step c) (Fig. 10), and the search is performed using the search term in a database which is organized by the list of the profiles and the at least one corresponding topic for each of the list of profiles (col. 2, line 56 – col. 3, line 8). Meske Jr. also discloses the search result may also create certain HTML files responsive to user search requests (in response to step c above) and additional HTML files created responsive thereto, wherein anchors are created in the various files in order to allow hypertext cross-referencing of the various related file and/or documents (col. 5, lines 58 – col. 7, line 2, Fig. 9, 10, 11A-11C and 12A-12B). Sotomayor and Meske Jr. are analogous art because they are from the same field of endeavor that is retrieving information from index files. The suggestion/motivation for doing so would have been to provide information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing. Therefore, it would have been obvious to combine Sotomayor and Meske Jr. to obtain the invention as specified in claim 36.)

d. Claims 52-54, since Examiner's cited the first reference which is Sotomayor for rejecting claims 52 and 53, therefore, there is no need to provide motivation.

As to claim 53, Sotomayor-Meske disclose wherein said concepts are considered related to one another when both are related to a third concept (Meske, Abstract: Meske

Jr. provides information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing. Sotomayor and Meske Jr. are analogous art because they are from the same field of endeavor that is retrieving information from index files. The suggestion/motivation for doing so would have been to provide information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing. Therefore, it would have been obvious to combine Sotomayor and Meske Jr. to obtain the invention as specified in claim 36.)

e-i. Claims 58-60 and 62-63, since Examiner's cited the first reference which is Sotomayor for rejecting claims 58-60 and 62-63, therefore, there is no need to provide motivation.

j. Claim 66, Sotomayor-Meske disclose wherein additional information resident on the reader's computer influences said search request (Meske, Abstract and Figs. 9-11: Meske Jr. provides information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of

the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing. Sotomayor and Meske Jr. are analogous art because they are from the same field of endeavor that is retrieving information from index files. The suggestion/motivation for doing so would have been to provide information retrieval, which includes the receipt of a plurality of information, organized by profile and topic in a first markup language, and the parsing of the plurality of information into portions of information in a second markup language, including anchors referencing each of the portions of information to allow hypertext viewing and accessing. Therefore, it would have been obvious to combine Sotomayor and Meske Jr. to obtain the invention as specified in claim 36.)

**3. Claim 42 is rejected under 35 USC 103 over Sotomayor in view of Meske and Boguraev.**

3-a. The references, taken as a whole, do not suggest the subject matter of claim 42.

In reply to argument 3-a, Sotomayor-Meske disclose the limitations as discussed above. However, Sotomayor-Meske do not explicitly disclose wherein the method of formulating said search request comprises analyzing the frequency with which at least one word appears in said text section relative to other words. Buguraev discloses a method for creating a catalog comprising key terms, properties thereof, relations involving those key terms for a given topic comprises clustering key terms on the basis

of proximity in terms of their relative position in the text (col. 4, line 60 – col. 5, line 48). Since Buguraev teaches a method for creating a glossary, index, help database or the like, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the index method of Buguraev into the search system of Sotomayor-Meske to include gathering key terms on the basis of proximity in terms of relative position in the text. By doing so, it would create an online help database useful in providing online assistance to users in performing a task.

3-b. No motivation to combine Sotomayor with Meske and Boguraev is described in the references or in the knowledge generally available to one of ordinary skill in the art.

In reply to argument 3-b, applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Please see the response to argument to 3-a above.

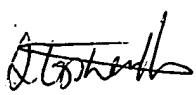
3-c. Sotomayor, Meske, and Boguraev are individually complete.

In reply to argument 3-c, Sotomayor discloses creating summary pages by automatically identifying key topics, concepts, and phrases in the documents and indexing them so users can retrieve and search the index (Abstract, col. 4, lines 10-48 and col. 35, lines 48-57). Meske disclose a searchable index web site that users can search and retrieve information from an index database (Abstract and Figs. 9-10, 11A-11C and 12A-12B). Boguraev discloses extracting knowledge from online documentation and creating a glossary, index, and help database useful in providing online assistance to users in performing a task (Abstract, and col. 4, line 54 – col. 5, line 48). Therefore, Sotomayor, Meske Jr. and Boguraev are analogous art because they are from the same field of endeavor that is retrieving information from index files.

For the above reasons, it is respectfully submitted that the rejections should be sustained.

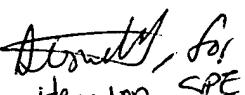
Conferee:

Respectfully Submitted,



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